



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,910	06/04/2001	Allan Williams	P-001	2026

7590

01/12/2006

Dr. Victoria Donnelly  
Hazeldean R.P.O.  
P.O. Box 24001  
Kanata, ON K2M 2C3  
CANADA

EXAMINER
----------

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/871,910	<b>Applicant(s)</b> WILLIAMS ET AL.	
	<b>Examiner</b> Nathan Hillery	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-16,19,21-27,37-40,43,46,47 and 51-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-16,19,21-27,37-40,43,46,47 and 51-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/25/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: IDS filed on 5/18/05.
2. Claims 1, 2, 5, 7 – 16, 19, 21 – 27, 37 – 40, 43, 46, 47 and 51 – 56 are pending in the case. Claims 1, 12 – 15, 24, 25, 39, 40, 46, and 51 are independent.
3. The rejection of claims 12, 24, 46 and 47 under 35 U.S.C. 101 as being nonstatutory has been maintained.
4. The rejection of claims 7, 13, 21 and 37 under 35 U.S.C. 112 as being indefinite has been withdrawn as necessitated by amendment.
5. The rejection of claims 1, 2, 5, 7 – 16, 19, 21 – 27, 37 – 40, 43, 46, 47 and 51 under 35 U.S.C. 102 as being anticipatory has been maintained.

### ***Information Disclosure Statement***

6. The information disclosure statement filed 10/25/05 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the IDS has not provided a full citation including dates of the non-patent literature cited on the 1449 instead the URL of entire websites have been cited. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12, 24, 46 and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention amounts to nonfunctional descriptive data stored in memory. Because the claims simply set forth mere arrangements and/or compilations of data in memory, the claimed invention is non-statutory.

9. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 54 – 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The term "substantially linear" in claim 54 is a relative term which renders the claim indefinite. The term "substantially linear" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one

of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Consequently, the substantially linear tree recited in claim 54 has been rendered indefinite. Furthermore, all subsequent recitations of "substantially linear tree" are also rejected. For purposes of this examination, the Office shall interpret "substantially linear tree" as any linear or nonlinear tree, since a tree is either linear or nonlinear, and since it is unclear exactly how a tree can be substantially linear.

13. Regarding dependent claims 55 and 56, the claims are rejected for fully incorporating the deficiencies of the base claim (s) from which they depend.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 2, 5, 7 – 16, 19, 21 – 27, 37 – 40, 43, 46, 47, 51 and 52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rivette et al. (US006339767B1 filed 8/29/97).

16. **Regarding independent claims 1, 12 – 15, 24, 25, 39, 40, 46 and 51,** Rivette et al. teach that *referring again to FIG. 168, further in step 16816, the client 304/306 uses the claims dependency tree 18502 to generate the patent claims hyperbolic tree 17101. In generating the hyperbolic tree, a hyperbolic tree node is generated for each node in*

*the claims dependency tree 18502. Also, links between nodes in the patent claims hyperbolic tree 17101 correspond to links in the claims dependency tree 18502. In addition to linking information, the nodes in the patent claims hyperbolic tree 17101 may also include any claim information that was in the corresponding node of the claims dependency tree 18502, such as claim text. The node type and the sub-type are also stored in the nodes of the patent claims hyperbolic tree 17101. The node type refers to whether or not the node is a patent node (such as node 17104) or a claim node (such as node 17108A). The sub-type refers to whether the node corresponds to an independent claim (such as nodes 17106) or a dependent claim (such as nodes 17108A and 17108B). Further details concerning construction of a hyperbolic tree representative of the claims dependency tree 18502 will be apparent to persons skilled in the relevant art(s) (Column 137, lines 10 – 30) and that in step 16822, the client 304/306 retrieves information on the selected claim, such as the text of the selected claim, and displays the claim text. The invention includes a number of formats for displaying the claim text. For example, FIG. 172 illustrates a display format 17202 where the text of the claim is displayed independent of and apart from the patent. In contrast, FIG. 173 illustrates a display format 17302 where the claim is displayed in the context of the patent (Column 137, line 65 – Column 138, line 5), compare with (a) selecting a claim section of the patent document; (b) processing the claim section, including: (c) extracting claim dependency and text of claims from the interchanged claim section; (d) converting the extracted claim dependency into a graphical form, comprising a set of graphical elements, each element*

corresponding to an individual claim or a group of claims; (e) converting the extracted text of claims into a textual form, comprising a set of elements, each element being a text of an individual claim or a text of a group of claims; (f) forming a derivative claim section by combining the converted graphical and textual elements of the converted claim dependency and text of claims in the order obtained after the step (iii) of interchanging; and (g) forming the derivative document by combining the derivative claim section with the patent document or a part of the patent document. Rivette et al. illustrate in Figs. 181 and 183 and also teach that *some well known hyperbolic browser implementations are capable of generating and displaying hyperbolic trees directly from DAGs. These hyperbolic browser implementations conceptually operate by mapping the root node in the DAG to the root node in the hyperbolic tree. Also, non-root nodes in DAG that have a single parent node are directly mapped to corresponding nodes in the hyperbolic tree. These hyperbolic browser implementations conceptually map non-root nodes in the DAG that have multiple parent nodes to multiple nodes in the hyperbolic tree, wherein each of these tree nodes are linked to a single parent node in the hyperbolic tree. This is shown in FIG. 179, where node D has parent nodes B and C in DAG 17902. As a result of this conceptual mapping process in hyperbolic browser, nodes 17906A and 17906B are created in the hyperbolic tree 17904. Each of these nodes 17906A and 17906B is linked to a single parent node (that is, nodes B and C) in the hyperbolic tree 17904. The process of generating and populating a hyperbolic tree from a DAG by such hyperbolic browser implementations will be apparent to persons skilled in the relevant*

*art(s)* (Column 123, line 59 – Column 124, line 12), compare with **(i) transforming multiple dependent claims into single dependent claims; (ii) sorting the transformed claims by claim numbers to which the claims refer; (iii) interchanging positions of any two neighboring sorted claims, the proceeding claim and the succeeding claim, if they meet the following requirements: both claims are dependent claims and refer to different claims; and succeeding claim does not refer to the preceding claim.**

17. Regarding dependent claims 2 and 16, Rivette et al. teach that *referring again to FIG. 168, further in step 16816, the client 304/306 uses the claims dependency tree 18502 to generate the patent claims hyperbolic tree 17101. In generating the hyperbolic tree, a hyperbolic tree node is generated for each node in the claims dependency tree 18502. Also, links between nodes in the patent claims hyperbolic tree 17101 correspond to links in the claims dependency tree 18502. In addition to linking information, the nodes in the patent claims hyperbolic tree 17101 may also include any claim information that was in the corresponding node of the claims dependency tree 18502, such as claim text*

(Column 137, lines 10 – 20), compare with **the steps of converting further comprises establishing links between the elements of the graphical and textual subsets according to the transformed claim dependency.**

18. Regarding dependent claims 5, 8, 19 and 38, Rivette et al. teach that *in step 16822, the client 304/306 retrieves information on the selected claim, such as the text of the selected claim, and displays the claim text. The invention includes a number of*



*formats for displaying the claim text. For example, FIG. 172 illustrates a display format 17202 where the text of the claim is displayed independent of and apart from the patent. In contrast, FIG. 173 illustrates a display format 17302 where the claim is displayed in the context of the patent (Column 137, line 65 – Column 138, line 5), compare with*

**displaying the selected subsets of elements on a computer screen; and**

**displaying the selected subsets of elements on a computer screen in combination with other elements of the sets; and the step (g) comprises a step selected from the list consisting of: forming the document so that the derivative claim section is replacing the claim section of the patent document; forming the document so that the derivative claim section is supplementing the patent document; forming the document so that derivative claim section is supplemented by a part of the patent document; and forming the document so that the derivative document derivative claim section of the patent document.**

19. **Regarding dependent claims 7, 9 – 11, 21 – 23, 26, 27 and 47, Rivette et al.** teach that *Specifically, the enterprise server 314 sends raw data 802 to the web server 310 over the network 312. The translator 804 in the web server 310 translates the raw data 802 to data in the well known HTML data format. This HTML data 806 is sent to the web client 304 over network 308. A browser 808 in the web client 304 renders the HTML data 806. The translator 804 translates data going from the web client 304 to the enterprise server 314 in a similar manner. It is noted that data formats other than HTML could alternatively be used. In particular, any data format used by the browser 808 could alternatively be used in the invention (Column 38, lines 44 – 54), compare with*

**the step (e) comprises converting into the form selected from the list consisting of ASCII, HTML, SGML, XHTML, and XML formats; a step of performing one or more of the following: storing data obtained in at least one of the steps in a database; sending data obtained in at least one of the steps over a network; compressing data obtained in at least one of the steps; displaying one of the derivative document and the derivative segment on a computer screen; the step (b) comprises distributed processing of the patent document in a network environment performed by using processing power of more than one computer; the step of distributed processing comprises the steps initial processing of the document performed on server side and final processing performed on a client side; and the derivative document being presented in a web compatible form such that to be recognized by a browser.**

20. **Regarding dependent claim 37**, Rivette et al. teach that *in step 16906, the client 304/306 selects one of the nodes of the DAG 18402 (or, equivalently, the client 304/306 selects one of the claims of the '011 patent). In step 16908, if the selected claim is an independent claim, then the client 304/306 creates a link from the root node to the selected node. For example, if claim 1 is the selected claim, then the client 304/306 creates a link between node 18406 to the root node 18408. Information representative of the link is stored in the parent of the selected claim. For example, information representing the link between node 18406 and the root node 18408 is stored in root node 18408. If the selected claim is a dependent claim, then in step 16908 the client 304/306 creates a link between the selected node and each node*

*(called parent nodes) corresponding to a claim from which the selected claim depends.*

*Information representing these links is stored in the parent nodes (Column 135, line 61*

*– Column 136, line 10), compare with **the step of selection of the subset of elements***

**comprises the step selected from the list consisting of: selecting the subset**

**comprising only one element in one form, and displaying the selected subset in**

**said one form with the related subset comprising the corresponding element of**

**the other form; selecting the subset comprising only one element of in one form,**

**and displaying the selected subset in said one form along with the related subset**

**in the other form comprising first and second elements, wherein the first element**

**corresponds to the selected element of the first form, and the second element is**

**the element on which the first element refers to according to claim dependency;**

**selecting the subset comprising elements of one form corresponding to**

**independent claims only, and displaying the selected subset in said one form**

**along with the related subset in the other form comprising elements of the other**

**form corresponding to the selected elements of the said one form; selecting the**

**subset comprising elements in one form corresponding to an independent claim**

**and all the dependent claims referred thereto only, and displaying the selected**

**subset in said one form along with the related subset comprising elements in the**

**other form corresponding to the selected elements in said one form; and**

**selecting the first subset comprising an independent claim only in one form, and**

**displaying the selected subset in said one form along with the related subset**

**comprising elements in the other form corresponding to the selected independent claim and all dependent claims referred thereto.**

21. **Regarding dependent claim 43**, Rivette et al. teach that *some well known hyperbolic browser implementations are capable of generating and displaying hyperbolic trees directly from DAGs. These hyperbolic browser implementations conceptually operate by mapping the root node in the DAG to the root node in the hyperbolic tree. Also, non-root nodes in DAG that have a single parent node are directly mapped to corresponding nodes in the hyperbolic tree. These hyperbolic browser implementations conceptually map non-root nodes in the DAG that have multiple parent nodes to multiple nodes in the hyperbolic tree, wherein each of these tree nodes are linked to a single parent node in the hyperbolic tree. This is shown in FIG. 179, where node D has parent nodes B and C in DAG 17902. As a result of this conceptual mapping process in hyperbolic browser, nodes 17906A and 17906B are created in the hyperbolic tree 17904. Each of these nodes 17906A and 17906B is linked to a single parent node (that is, nodes B and C) in the hyperbolic tree 17904. The process of generating and populating a hyperbolic tree from a DAG by such hyperbolic browser implementations will be apparent to persons skilled in the relevant art(s) (Column 123, line 59 – Column 124, line 12), compare with the step (i) further comprises one of the following: adding single dependent claims generated from multiple dependent claims to the end of original set of claims; or inserting claims generated from a multiple dependent claim into original set of claims immediately*

**after the multiple dependent claim, followed by re-numbering of claims starting from the multiple dependent claim and to the end of claim section.**

22. **Regarding dependent claim 52**, Rivette et al. teach that *referring again to FIG. 168, further in step 16816, the client 304/306 uses the claims dependency tree 18502 to generate the patent claims hyperbolic tree 17101. In generating the hyperbolic tree, a hyperbolic tree node is generated for each node in the claims dependency tree 18502. Also, links between nodes in the patent claims hyperbolic tree 17101 correspond to links in the claims dependency tree 18502. In addition to linking information, the nodes in the patent claims hyperbolic tree 17101 may also include any claim information that was in the corresponding node of the claims dependency tree 18502, such as claim text. The node type and the sub-type are also stored in the nodes of the patent claims hyperbolic tree 17101. The node type refers to whether or not the node is a patent node (such as node 17104) or a claim node (such as node 17108A). The sub-type refers to whether the node corresponds to an independent claim (such as nodes 17106) or a dependent claim (such as nodes 17108A and 17108B). Further details concerning construction of a hyperbolic tree representative of the claims dependency tree 18502 will be apparent to persons skilled in the relevant art(s) (Column 137, lines 10 – 30) and that in step 16822, the client 304/306 retrieves information on the selected claim, such as the text of the selected claim, and displays the claim text. The invention includes a number of formats for displaying the claim text. For example, FIG. 172 illustrates a display format 17202 where the text of the claim is displayed independent of and apart from the patent. In contrast, FIG. 173 illustrates a display format 17302 where the claim*

Art Unit: 2176

*is displayed in the context of the patent* (Column 137, line 65 – Column 138, line 5), compare with **associating the derivative claim section with a computer program providing a user interactive selection of a subset of elements in one of the graphical and textual forms, and displaying said subset in the selected form along with the related subset of elements according to the claim dependency in the other form to a user claims in the order obtained after the step (iii) of interchanging.**

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 53 – 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (US006339767B1 filed 8/29/97).

25. **Regarding dependent claims 53 – 56**, Rivette et al. teach that *referring again to FIG. 168, further in step 16816, the client 304/306 uses the claims dependency tree 18502 to generate the patent claims hyperbolic tree 17101. In generating the hyperbolic tree, a hyperbolic tree node is generated for each node in the claims dependency tree 18502. Also, links between nodes in the patent claims hyperbolic tree 17101 correspond to links in the claims dependency tree 18502. In addition to linking information, the nodes in the patent claims hyperbolic tree 17101 may also include any claim information that was in the corresponding node of the claims dependency tree*

*18502, such as claim text. The node type and the sub-type are also stored in the nodes of the patent claims hyperbolic tree 17101. The node type refers to whether or not the node is a patent node (such as node 17104) or a claim node (such as node 17108A). The sub-type refers to whether the node corresponds to an independent claim (such as nodes 17106) or a dependent claim (such as nodes 17108A and 17108B). Further details concerning construction of a hyperbolic tree representative of the claims dependency tree 18502 will be apparent to persons skilled in the relevant art(s) (Column 137, lines 10 – 30) and that in step 16822, the client 304/306 retrieves information on the selected claim, such as the text of the selected claim, and displays the claim text. The invention includes a number of formats for displaying the claim text. For example, FIG. 172 illustrates a display format 17202 where the text of the claim is displayed independent of and apart from the patent. In contrast, FIG. 173 illustrates a display format 17302 where the claim is displayed in the context of the patent (Column 137, line 65 – Column 138, line 5), compare with **the step (c) of extracting claim dependency comprises forming a respective triplet for each interchanged claim, the triplet comprising first, second and third elements which are respectively as follows: a claim number; a vertical offset, characterizing a vertical position of the claim, which is defined by the relative position of the claim compared to the first claim in the interchanged set of claims; a horizontal offset, characterizing a horizontal position of the claim, which is defined by the level of claim dependency for the claim, that the step (d) of converting comprises converting said triplets into respective graphical elements which are arranged into a***

**substantially linear tree, wherein vertical and horizontal positions of the graphical elements in the tree are defined by the vertical and horizontal offsets in the respective triplets, that the step (c) further comprises forming a corresponding quadruplet for each interchanged claim, the quadruplet comprising the respective triplet and a fourth element, which is a text of the claim, that the step (f) comprises a simultaneous displaying a subset of graphical elements from said substantially linear tree along with the related subset of fourth elements form the quadruplets.** Rivette et al. do not explicitly teach **vertical and horizontal offset**; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to be well aware that representing claims of a patent document in a tree like manner involves placing certain nodes on the same level based on dependency and placing children nodes below parent nodes to demonstrate the 'ancestry' to the user, as is further evidence by the illustrations of Rivette et al. in Figs 177 – 179, since Rivette et al. teach that *Further details concerning construction of a hyperbolic tree representative of the claims dependency tree 18502 will be apparent to persons skilled in the relevant art(s)* (Column 137, lines 28 – 30).

### ***Response to Arguments***

26. Applicant's arguments filed 10/25/05 have been fully considered but they are not persuasive.

27. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a meaningful and comprehensive simultaneous displaying of both claim tree and



text of claims; as simple as possible processing, preparation and displaying; simple and efficient method, which minimizes the processing time and guarantees the correct results) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

28. In response to applicant's argument(s) that Rivette et al. fail to teach, suggest, or disclose **(i) transforming multiple dependent claims into single dependent claims; (ii) sorting the transformed claims by claim numbers to which the claims refer; (iii) interchanging positions of any two neighboring sorted claims, the proceeding claim and the succeeding claim, if they meet the following requirements: both claims are dependent claims and refer to different claims; and succeeding claim does not refer to the preceding claim**, it should be noted that the Office contends Rivette et al. teach these limitations as explained in the newly cited passage of Rivette et al. in the rejection of claims under 35 USC 102(e) and in Figs 181 and 183.

29. In response to applicant's argument that Rivette et al. use a variable scale technique of hyperbolic trees instead of using a substantially linear manner, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, as explained in the rejection under 35 USC 112, second paragraph, it is unclear what is meant by "substantially linear".

***Conclusion***

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH

  
HEATHER R. HERNDON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100